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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/523,193 | 03/10/2000 | Sean Matthew Doherty | 169.1649 | 4782 |

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NEW YORK, NY 10112

EXAMINER

CHAMPAGNE, DONALD

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3622

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/523,193

Applicant(s)

SEAN MATTHEW DOHERTY

Examiner

Donald L. Champagne

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11, 14-24, 26 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11, 14-24, 26 and 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 26 October 2004 have been fully considered but they are moot in view of the following new basis of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 2-11, 14-24, 26 and 28-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Marsh et al. (US005848397A).
4. Marsh et al. teaches (independent claims 14, 26, 28, 29, 32 and 33, and dependent claims 2, 3, 30 and 31) a computer-executable method for scheduling items of information for display/presentation of an output device, an information processing apparatus for implementing said method, and a computer readable medium storing said method, the method comprising: (a) scheduling items of information (*advertisements*) in accordance with values of priorities, said scheduling determining an order for displaying/presenting said items of information (col. 2 line 66 to col. 3 line 1 and col. 8 lines 63-66); (b) generating a user interrupt in response to a user interacting with the user interface (the user *clicking on a specified portion of the banner ad 601*, col. 7 line 53-55), when a *showcase ad 1001* was also being displayed (col. 7 line 66 to col. 8 line 4 and col. 8 lines 24-27 with Fig. 4); (c) clearing the main screen of the showcase ad items on information in response to the user interrupt (in order to provide the user with the requested *additional information*, col. 7 lines 55-57); (d) logging the time of the interruption (col. 4 lines 30-37, col. 7 lines 17-18 and col. 8 line 11), which reads on estimating a time when the user will finish interacting with the user interface; (e) rescheduling items of information for display/presentation in accordance with the values of the priorities (col. 4 lines 37-39); (f) repeating steps (d) to (e) if the user is still interacting with the user interface at the end of the first interruption, which reads on at

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the estimated time; and (g) displaying the information as scheduled if the user is not interacting with the user interface at the estimated time.

5. Marsh et al. also teaches claims 4, 7, 15 and 18 (col. 3 line 67), claims 5 and 16 (col. 15 line 36), claims 8 and 19 (col. 4 line 1), claims 6 and 17 (maximum number of exposures, col. 4 line 1, per *time to expiration*, col. 3 line 67, is a frequency), claims 8 and 19 (col. 4 line 1), claims 9 and 20 (col. 15 lines 54-56), claims 10, 11, 21 and 22 (col. 15 lines 56-62).
6. Marsh et al. also teaches claims 23 and 24 as the process described from col. 8 line 63 to col. 9 line 27, where the *highest priority* reads on a maximum priority.
7. Marsh et al. does not explicitly teach (claim 31) that said determining step comprises keystrokes. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that said determining step would comprise keystrokes if the user were inputting data into the template form or email message described at col. 7 lines 57-65.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
9. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

29 April 2005